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AMIN, TUROCY & CALVIN, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114			EXAMINER HAMILTON, MATTHEW L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/749,653	Applicant(s) MOSS ET AL.	
	Examiner MATTHEW L. HAMILTON	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is in reply to the amendment filed on 29 October 2008. Claims 1, 15, 21 and 28 have been amended. 1-25 and 27-32 are currently pending and have been examined.

2. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Inventorship

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Previous Claim Objections

4. Claim 21 was objected to because of the following informalities: it appears the Applicant forgot to add the letter "s" after the word customer in lines 6 and 8. The Applicant has amended the claim to overcome the objection. The objection has been withdrawn.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted to be a computer program, does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). Computer programs are nonstatutory functional descriptive material (MPEP § 2106.01.I, last para.).

7. Claims 21-25 and 27-32 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, __F.3d__, 2008 WL4757.

8. Applicant argues on page 9 of the remarks, "With regards to claims 21 and 31, applicants' representative respectfully disagrees with the Examiner's reading of the claims. Both of these claims clearly and explicitly demonstrate an interaction with the physical world based on an interaction with a user". This is not compelling for two reasons. First, the criterion is "tied to a particular machine or apparatus", not "interaction with the physical world". Second

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the claims are not meaningfully limited/tied to a particular machine or apparatus. Third, it is not clear that the application even discloses a machine or apparatus. "System" is not disclosed to be anything more than software and no computer or other apparatus is disclosed. (See para. 10 below.)

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, "computer implemented" (line 1) and "a processor" (line 3) are new matter.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1-14, 27, 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3, 4, 13, 27, 31 and 32 each contain an improper Markush group (MPEP § 2173.05(h)).

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Non-Functional Descriptive Material

13. The following claim language is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A) as shown underlined below. Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

Claim 4:

The system of claim 1 further teaches *the one or more enhancements comprising at least one of the following:*

bolded listing; addition of a background to listing; alternative color of listing; addition of icon to listing; addition of "preferred listing" text to listing; addition of thumbnail to listing; at least partial animation of listing; alternative font type of listing; alternative font size of listing; stylized font of listing; play of sound when hovering over listing; and preferred location on display of listing.

Claim 5:

The system of claim 4 *the one or more enhancements are visible teach when hovering over the respective listing.*

Claim 6:

The system of claim 4 *at least a portion of the listing is bolded.*

Claim 7:

The system of claim 4 *the alternative color of the listing is different from a standard color of the listings.*

Claim 8:

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The system of claim 4 the alternative color is based at least in part upon user preferences.

Claim 9:

The system of claim 1 the one or more enhancements do not influence determining whether enhanced listings are relevant to search query, thereby retaining ordering rights to keep listings relevant and meaningful to users.

Claim 10:

The system of claim 1 the one or more enhancements facilitate differentiating enhanced listings from other listings on a search results display.

Claim 27:

The method of claim 21 the one or more selected enhancement options comprising at least one of: bolding at least a portion of listing; adding a background to at least a portion of listing; changing text color of listing to an alternative color different from a standard listing color; altering text font of listing to be different from a standard listing font; increasing font size of listing greater than standard listing font size; animating at least a portion of listing; dynamically replacing at least a portion of listing with at least one search term; adding a thumbnail to the listing corresponding to some content of the listing; replacing listing text with a thumbnail that is representative of the content in the listing; adding an icon to the listing that indicates a preferred status of the listing; and positioning the listing apart from other listings while retaining ordering rights based on relevance of listing with respect to search query.

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Claim 28:

The method of claim 21 globally applying the one or more enhancements to at least a subset of the plurality of listings.

Claim 29:

The method of claim 21 as described above the one or more enhancements are sensitive to at least one of cultural, time zone, and regional differences to mitigate offensive listings.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-2, 4, 11-15, 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Wen US Publication 2001/0047297 A1.

Claim 1:

As per claim 1, **Rodriguez** teaches a computer implemented system comprising:
a processor communicatively coupled to a memory;
an enhancement controller component that controls a plurality of enhancements related to a paid inclusion listing, the enhancement controller component interfacing with the paid inclusion customer to facilitate optimizing enhancement selection based in part upon at least one of the

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following: listing performance, historical data, customer preference, and user feedback (paragraphs 0007, 0023, 0042 and 0049).

Rodriguez teaches *related to a paid inclusion listing* (paragraphs 0007) does not teach a *selection component that allows a paid inclusion customer to select one or more enhancements*. However, **Wen** teaches an advertisement brokering with remote ad generation system and method in a distributed computer network in paragraph 0002 and further teaches, *“As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection” and “The advertiser selects certain “ad generation characteristics” to change the appearance or the presentation of the advertisement. As described herein, “ad generation characteristics” refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc”* (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a component that allows an advertiser to select one or more enhancements. One would have been motivated to add a component that allows an advertiser to select one or more enhancements to allow the advertisers to highlight and distinguish listings from one another.

Claim 2:

As per claim 2, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Rodriguez** further teaches *further comprising a display component operatively connected to the enhancement controller component for rendering one or more*

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search results, the search results comprising at least one enhanced listing (paragraphs 0023 and 0024).

Claim 11:

As per claim 11, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Wen** further teaches *further comprising one or more enhancement components which are controlled by the enhancement controller component and which correspond to a plurality of enhancements available to the paid inclusion customer* (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add one or more enhancements controlled by enhancement controller component corresponding to enhancements available to advertisers. One would have been motivated to add one or more enhancements available to advertisers in order to provide the advertisers the ability to decide how the listing should be displayed or designed.

Claim 12:

As per claim 12, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Rodriguez** further teaches *the user feedback comprising at least one of user hard-coded preferences and user behavior that facilitates customizing a manner in which the user views the listings* (paragraphs 0023 and 0024).

Claim 14:

As per claim 14, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Rodriguez** further teaches *the enhancement controller component*

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temporarily hides or suppresses one or more enhancements based at least in part upon user preferences (paragraph 0023).

Claim 15:

As per claim 15, **Rodriguez** teaches a system comprising:

one or more enhancement components that correspond to one or more enhancement options related to a paid inclusion listing (paragraphs 0007, 0023 and 0024);

a listing control component that controls the one or more enhancement components (paragraphs 0023 and 0024); and

a second input component that provides the listing control component with user preferences (paragraphs 0023 and 0024), whereby the listing control component balances the customer's enhancement selections with user preferences to optimize listing performance (paragraph 0049).

Rodriguez does not teach *a first input component that provides the listing control component with a paid inclusion customer's enhancement selections.* However, **Wen** teaches an advertisement brokering with remote ad generation system and method in a distributed computer network in paragraph 0002 and further teaches, *"As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection" and "The advertiser selects certain "ad generation characteristics" to change the appearance or the*

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presentation of the advertisement. As described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc." (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add an input component that provides an advertiser with enhancement selections. One would have been motivated to add an input component that provides an advertiser with enhancement selections in order for the advertiser to customize the display of the listing.

Claim 19:

As per claim 19, **Rodriguez** and **Wen** teach the system of claim 15 as described above and **Rodriguez** further teaches *the listing control component modifies one or more enhanced listings based at least in part upon a user's respective preferences on a per user basis* (paragraphs 0048 and 0049).

Claim 20:

As per claim 20, **Rodriguez** and **Wen** teach the system of claim 15 as described above but do not teach *the listing control component generates a plurality of parallel listings wherein at least a subset of the listings have respectively different enhancements to assist the paid inclusion customer in optimizing listing performance and revenues*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to generate a plurality of parallel listings with a subset of listings with different enhancements to help the advertiser select the listing leading to great performance and increased revenue. For example, consumer research marketing firms conduct research and surveys by asking questions to consumers regarding the appearance and effectiveness of similar but different

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advertisements. Once the feedback is generated, it helps advertisers determine advertisements that lead to expected increase in revenue, performance and success.

Claim 21:

As per claim 21, **Rodriguez** teaches a method comprising:

providing a plurality of listings to an end user (paragraph 0026) including at least one paid inclusion listing (paragraph 0007).

and rendering the plurality of listings based in part upon at least one of the one or more paid inclusion customers selected enhancement options and end user preferences (paragraph 0049).

Rodriguez does not teach *modifying at least a subset of the plurality of listings according to one or more paid inclusion customers selected enhancement options*. However, **Wen** teaches an advertisement brokering with remote ad generation system and method in a distributed computer network in paragraph 0002 and further teaches, "As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection" and "The advertiser selects certain "ad generation characteristics" to change the appearance or the presentation of the advertisement. As described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc." (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify a subset of the plurality of

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listings according to advertiser. One would have been motivated to modify a subset of the plurality of listings according to advertiser in order generate revenue and allow the advertiser to change the listings as needed.

Claim 23:

As per claim 23, **Rodriguez** and **Wen** teach the method of claim 21 as described above but do not teach *further comprising modifying at least a subset of the plurality of listings according to user preferences*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify a subset of plurality of listings according to user preferences in order to present listings that comply with user's preferences.

Claim 24:

As per claim 24, **Rodriguez** and **Wen** teach the method of claim 23 as described above but do not teach *wherein modifying at least a subset of the plurality of listings according to user preferences overrides one or more selected enhancement options*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify at least a subset of the plurality of listing according to user preferences overrides one or more selected enhancement option in order to present a variety listings in a manner requested by user.

Claim 25:

As per claim 25, **Rodriguez** and **Wen** teach the method of claim 23 as described above but do not teach *wherein modifying at least a subset of the plurality of listings according to user preferences personalizes one or more selected enhancement options to respective users*.

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However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify a subset of the plurality of listings according to user preferences in order to provide the listing that is individualized and personalized to meet the users' expectations.

16. Claims 3, 13, 16-18, 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 and Wen US Publication 2001/0047297 A1 as applied to claims 1 and 15 above, and further in view of Petropolous et al US Patent 7,042,502 B2.

Claim 3:

As per claim 3, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above but do not teach *the selection component is at least one of a pointing device, a stylus, a keyboard, a mouse, a joystick, and a touchpad*. However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"Mouse pointer 52 is common pointer, as may be controlled by a standard mouse, trackball, keyboard pointer, touch screen or any user manageable device hereinafter the term "mouse pointer" is used in the broadest sense the context permits to refer to any one or more of these navigation tools"* (column 3, lines 52-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a selection component is at least one of a pointing device, a stylus, a keyboard, a mouse, a joystick and a touchpad. One would have been motivated to add a selection component is at least one of a pointing device, a stylus, a keyboard, a mouse, a joystick and a touchpad in order to input information to a computing system.

Claim 13:

As per claim 13, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above but do not teach *further comprising a reporting component that provides reports comprising at least one of listing performance data, user feedback, historical data, and comparisons to historical data to the paid inclusion customer to facilitate optimizing revenues.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, "*Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search*" (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a reporting component that provides reports comprising at least one of the following: listing performance data, user feedback, historical data, and comparisons to historical data to the paid inclusion customer to facilitate optimizing revenues. One would have been motivated to add a reporting component that provides reports comprising at least one of listing performance data, user feedback, historical data, and comparisons to historical data to the paid inclusion customer to facilitate optimizing revenues in order to improve the search results and provide the user an efficient method to search information.

Claim 16:

As per claim 16, **Rodriguez** and **Wen** teach the system of claim 15 as described above a monitoring component that monitors at least one of user behavior and user *responses to listings with or without enhancements to facilitate assessing implicit user preferences*. However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"The invention contemplates that there is monitoring while the user evaluates the results page. More particularly, the invention contemplates that there is monitoring of any or all of the following: (i) which result is being previewed by order or rank, (ii) the length of each preview, (iii) the order of previewing, (iv) the number of results previewed per page, and (v) whether there is a click-through. These attributes of the user behavior may be forwarded across the network to a program-designated place and later used in a consideration process, which will lead to conclusions about relevance of the results originally presented. These conclusions can be used to alter the algorithm and/or data so that the same or similar queries will yield more relevant results"* (column 12, lines 22-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a monitoring component that monitors user behavior and user responses to listings with or without enhancements. One would have been motivated to add a monitoring component that monitors user behavior and user responses to listings with or without enhancements in order to study and gather information regarding user and search result.

Rodriguez and **Wen** do not teach *a reporting component that provides reports to respective paid inclusion customers regarding their respective listings and performance thereof*. However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant

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information in column 1, lines 16-23, and further teaches, *"Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search"* (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a reporting component that provides reports to advertisers. One would have been motivated to add a reporting component that provides reports to advertisers in order to gather data regarding search results.

Claim 17:

As per claim 17, **Rodriguez, Wen** and **Petropoulos** teach the system of claim 16 as described above but do not teach *the monitoring component operatively connected to the listing control component to facilitate balancing the customer's enhancement selections with implicit user preferences*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to balance the advertiser's enhancement selections with implicit user preferences in order to satisfy both advertisers and users requirements.

Claim 18:

As per claim 18, **Rodriguez, Wen** and **Petropoulos** teach the system of claim 17 as described above but do not teach *the listing control component stores user preferences*

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including implicit user preferences and hard-coded preferences in one or more databases. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to store implicit user preferences and hard-coded preferences in one or more databases. For example, department and grocery stores have computers equipped with databases with stored information related to the customer (shopping information, surveys, demographics, etc.).

Claim 22:

As per claim 22, **Rodriguez** and **Wen** teach the method of claim 21 as described above but do not teach *further comprising reporting performance of at least a subset of the plurality of rendered listings to respective paid inclusion customers to facilitate optimizing listing performance and revenues.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search"* (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Rodriguez to report performance of at least a subset of rendered listings to respective paid inclusion customers. One would have been motivated to report performance of

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at least a subset of rendered listings to respective paid inclusion customers in order to gather data regarding search results.

Claim 30:

As per claim 30, **Rodriguez** and **Wen** teach the method of claim 21 as described above but do not teach *further comprising hovering a pointing device over rendered enhanced listing to visualize enhancement*. However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, "A feature of the current invention is that the user is shown preview information when the mouse pointer 52 navigates or passes over a defined area such as first defined area 60, second defined area 61, or other defined areas 62, 64, 66, 61, 68 (Hereinafter, the action of navigating or passing the mouse pointer over a region is referred to as a "mouse over")." and "In one embodiment, upon a pre-defined placement or action of the pointer (e.g. mouse-over), instructions are sent to the user's web browser to automatically open an embedded preview window and render the relevant contextual information inline with the user's result" (column 4, lines 1-7 and lines 10-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a pointing device over rendered enhanced listing to visualize enhancement. One would have been motivated to add a pointing device over rendered enhanced listing to visualize enhancement in order to provide the user a graphical illustration of the listing.

17. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Petropolous et al. US Patent 7,042,502 B2.

Claim 31:

As per claim 31, **Rodriguez** teaches a method comprising:

enhancing at least a first subset of the plurality of listings with at least a first enhancement
(paragraphs 0023 and 0024).

enhancing at least a second subset of the plurality of listings with at least a second enhancement, the second enhancement being different from the first enhancement (paragraphs 0023 and 0024).

Rodriguez does not teach *generating a plurality of parallel listings including at least one paid inclusion listing*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to generate a plurality of parallel listings in order to provide the advertiser a listing with different enhancements.

Rodriguez does not teach *and reporting at least one of performance, user historical data, and user behavior with respect to the first and second subsets of the plurality of listings to respective paid inclusion customer to optimize listing performance and revenues*. However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, "*Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results .of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the*

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search" (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez report at least one of performance, user historical data, and user behavior with respect to the first and second subsets of listings. One would have been motivated to report at least one of performance, user historical data, and user behavior with respect to the first and second subsets of listings in order to gather data regarding search results.

Claim 32:

As per claim 32, **Rodriguez** and **Petropoulos** teaches the method of claim 31 as described above and **Rodriguez** further teaches *further comprising optimizing delivery of listings based at least in part upon at least one of the following: a user point of entry comprising a web-based entry and a user-application entry, time of day, and display device* (paragraphs 0023 and 0024).

Response to Arguments

18. Applicant's arguments filed 29 October 2008 have been fully considered but they are not persuasive. According to the Applicant's arguments on page 11 of the remarks disclose the following: *"Thus, in regard to independent claims 1 and 15 of the subject application, Wen does not cure the deficiency of Rodriguez, as discussed supra, failing to teach or disclose paid inclusion listing enhancements (claim 1 as amended recites "a selection component that allows a paid inclusion customer to select one or more enhancements related to a paid inclusion listing. Similar language is found in claim 15. Moreover, Wen fails to cure the deficiency of Rodriguez to teach or disclose enhancements to the listings being selectively enhanced by the paid inclusion customer/advertiser."* However, the Examiner points out to Rodriguez teaching and

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suggesting paid inclusion listings in paragraph 0007 disclosing *"Because of its effectiveness, the practice of paying for enhanced ranking position rapidly became widespread. Unfortunately, this practice introduces a substantial imperfection into the frictionless marketplace that the Web can become, because millions of naive users are being frequently directed to sites which have paid a premium for preferred placement, rather than to sites which may have more pertinent information. In theory, the Web makes it possible for customers to locate the best supplier, but it can deliver on that promise if the process is objective."* The Wen reference does teach a selection component that allows a paid inclusion customer to select one or more enhancements by disclosing the following: *"As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection" and "The advertiser selects certain "ad generation characteristics" to change the appearance or the presentation of the advertisement. As described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc"* (paragraphs 0073 and 0074).

19. Applicant denies the rejection without distinctly and specifically pointing out the supposed errors in the examiner's action. It is not sufficient to point out the supposed errors in the examiner's action. This fails to comply with 37 CFR 1.111(b). For example, on page 12 of the remarks, applicant attempts to traverse the rejection of claims 9-10, 15, 17-18, 20, 23-25 and 28 but does not distinctly and specifically point out the supposed errors in the examiner's action regarding obviousness.

20. Applicant denies the rejection without distinctly and specifically pointing out the supposed errors in the examiner's action. It is not sufficient to point out the supposed errors in the examiner's action. This fails to comply with 37 CFR 1.111(b). For example, on pages 13

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and 15 of the remarks, applicant attempts to traverse the rejection of claims 21, 23-25, 28 and 31-32 but does not distinctly and specifically point out the supposed errors in the examiner's action, for example "Applicants respectfully disagree for at least the following reason. Independent claim 21 is believed to be allowable over Rodriguez and Wen as disclosed supra. Harik does not cure this deficiency." and "Applicants respectfully disagree for at least the following reason. Independent claim 31 is believed to be allowable over Rodriguez and Wen as disclosed supra. Petropolous does not cure this deficiency."

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. HAMILTON whose telephone number is (571)270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MLH
Examiner, Art Unit 3688
January 14, 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688